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Mailed: 12 FEB 2004
Paper No. 18
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DataMirror Corporation

Serial No. 75203278

John R. Garber of Cooper & Dunham LLP for DataMirror Corporation.

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Before Quinn, Bucher, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 25, 1996, DataMirror Corporation (applicant) applied to register the mark TRANSFORMATION SERVER, in typed form, on the Principal Register for goods ultimately identified as "computer software for use in extraction, filtering, reformatting and replication of data between the compatible and incompatible database software and computer platforms" in International Class 9.

The application (Serial No. 75203278) is based on an allegation of a bona fide intention to use the mark in commerce and the ownership of a foreign application (Canadian Application No. 826,508¹). In a paper dated August 11, 1998, applicant disclaimed the term "server."

The examining attorney² refused to register applicant's mark on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), of a feature of applicant's goods. The examining attorney argues that "data transformation may be accomplished by the extraction, filtering, reformatting and replication of data in order to overcome compatibility issues between database software and/or computer platforms." Brief at 5. Inasmuch as the examining attorney found that the software was used with or comprises a server for data transformation, the mark was merely descriptive of applicant's software. Applicant, on the other hand, submits that its mark is suggestive because it

¹ Subsequently, applicant provided a copy of Canadian Registration No. 512,413, filed October 21, 1996 and issued on May 28, 1999.

² The current examining attorney was not the original examining attorney in this case.

"requires thought, perception and imagination to make such a connection." Brief at 5.³

After the examining attorney made the refusal final, applicant appealed to this Board.⁴

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or

³ Applicant's Brief (pp. 3-4) begins with a section entitled "No explanation was ever given as to why the mark TRANSFORMATION SERVER was withdrawn from publication." To the extent that applicant is dissatisfied with this decision of the Deputy Commissioner, it is not a matter that is appealable to this Board. 37 CFR § 2.146; TBMP § 1201.05(b). We note that the examining attorney requested the Deputy Commissioner to restore jurisdiction "for action in accordance with the attached Office action." This Office action informed applicant of the Deputy Commissioner's decision to restore jurisdiction and it attached more than sixty pages of evidence.

⁴ With its Reply Brief, applicant attached a brochure of applicant describing its products. This submission is manifestly untimely and we will not consider it. TBMP § 1203.02(e).

services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney relies on the following evidence to show that applicant's mark is descriptive. First, the examining attorney requests that we take judicial notice of the following definitions, which we do⁵:

Transformation - 1. a. The act or an instance of transforming. b. The state of being transformed... 3. *Mathematics*. a. Replacement of the variables in an algebraic expression by their values in terms of another set of variables. b. A mapping of one space onto another or onto itself.

Server - *Computer Science*. A computer or program that controls a central repository of data that can be downloaded or manipulated by a client.⁶

Even more significant than these dictionary definitions are the numerous uses of the words "transformation" and "server" from the Internet or electronic databases that the examining attorney has submitted.

Functioning as a color transformation server, it can process rgb scans, Photo CD files, color Illustrator and FreeHand files.
ASAP, September 1, 1993.

Any of these can be overcome with custom programming or connection to third-party products, but, out of the box, eXcelon should be viewed as a transformation server.

⁵ University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁶ *American Heritage Dictionary of the English Language* (3rd ed. 1992).

ASAP, November 1, 1999.

The DMC data warehouse transformation server, a NetFRAME NT Server by MicronElectronics, receives data from an RS/6000 that acts as the interface server.
DM Review, September 1999.

The product also uses a transformation server, and can be customized with Microsoft's Visual Basic for Applications technology.
InfoWorld Daily News, May 24, 1999.

[O]rganizations will have to use application servers such as Netscape Application Server or data transformation servers such as Constellar Corp.'s Constellar Hub for easy access to this data.
ASAP, January 25, 1999.

The suite consists of client tools, plus a data transformation server that integrates through the metadata repository.
Database Web Advisor, May 1997.

A document would be sent initially to an "import/export" server, which would enlist the assistance of a representation transformation server" [sic] if the document was not in a standard format ready for storage.
ASAP, September 1990.

Another analyst, Bill Redman of GartnerGroup, Inc., also thinks transformation servers will be particularly hot.
ASAP, January 1, 2001.

The integration of the database and OWB allows Oracle8i to act as a transformation server, so that an additional transformation server is not needed.
ASAP, April 26, 2000.

To complement VortexXML Designer, Datawatch will release VortexXML Server, a high performance server engine that automates data transformation into XML, later this year.
ASAP, October 1, 2002.

The product, comprised of the Contivo EIM Server and Contivo Analyst, is designed to automate data transformation that takes place during application integration.

InfoWorld Daily News, June 17, 2002.

That means REBOL can act as an intermediate Web server, loading in data (like XML files) and performing localized transformations on the data before sending it on to the browser.

new.architect, April 1, 2002.

Studdard, who has used Microsoft's BizTalk Server, an XML transformation engine, to support a collection of .Net applications, has been tweaking the server with his own code.

Network World, July 29, 2002.

But the bulky transformations were bogging down servers.

Network World, September 23, 2002.

Servers can be cascaded to create a highly scalable real-time content transformation.

www.mobilewebsurf.com

San Mateo, Calif.-based AvantGo is another player in the transformation server arena.

Electronic News Online, January 1, 2001.

The examining attorney also included an extract from *The Rational Edge* website entitled "From Craft to Science: Rules for Software Design" that contained the following definition: "Transformation Server - Transformation servers perform the transformation from input data to output data, while possibly updating internal data." The flow chart in the article then shows how the transformation server interacts with the I/O servers and the Data Flow Manager.

The evidence⁷ relating to applicant's products shows that this software does indeed transform data on or in conjunction with servers.

DataMirror Transformation Server is an innovative software solution that allows users to capture, transform and flow data bi-directionally and in real-time between DB2 UDB, Microsoft SQL Server... DataMirror press release, November 7, 2002.

Transformation Server
DataMirror
Data Replication and transformation system enabling enterprise data distribution over mixed databases running on Windows NT, UNIX and AS/400 systems...Available for IBM AS/400 systems and Microsoft SQL Server.
Enterprise.CNET.com.

DaataMirror®
Solutions for Data Replications & Transformation

This exciting part of our business provides solutions for data replication and data transformation iSeries and AS/400, but also for Windows NT-servers, UNIX, and S/390!
www.sosy.dk.

⁷ We note that two of the articles below are from foreign websites. However, both of these articles discuss applicant's products, not the use of a term in a foreign country. Also, the Board has held that "it is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely available to these same professionals and to the general public in the United States. Particularly in the case before us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin." In re Remacle, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002)

DataMirror Transformation Server software is a flexible, high performance, peer-to-peer integration solution that enables users to capture, transform and flow data in real time throughout the enterprise and across the Internet... Transformation Server provides bi-directional data integration among DB2/UDB, Microsoft SQL Server, Oracle and Sybase ... www.spacetec.co.uk.

Indeed, data transformation is advertised as a significant feature of applicant's software. Also, articles about applicant's products use the term descriptively when they refer to applicant's software.⁸ Therefore, the applicant's term TRANSFORMATION SERVER is at least merely descriptive of applicant's computer software for use in extraction, filtering, reformatting and replication of data between the compatible and incompatible database software and computer platforms.⁹

Regarding applicant's arguments against the descriptiveness of its mark, we cannot agree that all the references to "transformation servers" refer "to very specific technical terms." Reply Brief at 2. For example, the *Rational Edge* website defines transformation servers in

⁸ See *Computer Reseller News*, March 8, 1999 ("DataMirror, with its experience in transformation servers and replication services, is a logical player for that arena").

⁹ Applicant argues generally that "[m]any, if not most, of the cited articles referencing use of the mark TRANSFORMATION SERVER are in fact referencing such use by Applicant." Brief at 5-6. While a few do, most of the articles are general in nature or refer to other entities. These articles are normally in third-party publications and the authors of those articles apparently believed that the term "transformation server" was descriptive.

the most general way ("Transformation Server - Transformation servers perform the transformation from input data to output data, while possibly updating internal data"). Applicant's arguments that "the use of the term 'Transformation' in the software industry was extremely rare and virtually unheard of at the time applicant adopted and began using its TRANSFORMATION SERVER trademark" and that "Applicant achieved significant commercial success" with its software are unsupported by the record. Applicant has not submitted any evidence on these points. We also note that there is no evidence of when applicant began using its mark. The only "evidence" on this point is the filing dates of this intent-to-use application and its Canadian application. We note that at least two of the references (*ASAP*, September 1, 1993 and *ASAP*, September 1990) precede even these dates.

When we analyze the evidence, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. Abcor Dev., 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require

consideration of its mark 'when applied to the goods' as required by statute").

Based on this evidence, we conclude that the terms "transformation" and "server" are at least descriptive terms when applied to applicant's computer software. Applicant's software, which extracts, filters, reformats and replicates data, is transforming data and its software would also comprise or be used with servers. The combined term "transformation server" also is at least as descriptive as the individual terms. There is ample evidence that the combined term is used to describe computer hardware or software that transforms data. When we view the mark TRANSFORMATION SERVER in the context of computer software for use in extraction, filtering, reformatting and replication of data between the compatible and incompatible database software and computer platforms, the term will immediately inform prospective customers of the fact that applicant's software involves data transformation with or comprising servers and, as such, it would describe a significant characteristic of the goods. Therefore, we find that applicant's term is merely descriptive of the goods identified in the application.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.